

REMARKS

The outstanding Restriction Requirement required restriction of the claims in the present application to one of a number of identified distinct (as claimed) inventions (as identified by the Examiner) in accordance with the provisions of 35 U.S.C. § 121. In particular, the Restriction Requirement asserted that identified Groups of claims in the present application are directed to the following distinct (as claimed) inventions:

Invention I, to which the claims of Group I comprising claims 1-8 and 16-23 (as identified by the Examiner) are directed, drawn to a diagnosis supporting device comprising an image signal acquiring section. The Restriction Requirement asserted that these claims are classified in class 382, subclass 128.

Invention II, to which the claims of Group II comprising claims 9-15 (as identified by the Examiner) are directed, drawn to a diagnosis supporting device comprising an information register and a condition deciding section. The Restriction Requirement asserted that these claims are classified in class 600, subclass 101.

The Restriction Requirement asserted that Inventions I and II are related as combination and subcombination. The Restriction Requirement further asserted that the identified combination of Invention I does not require the particulars of the identified subcombination of Invention II for patentability. The Restriction Requirement additionally asserted that the identified subcombination of Invention II has separate utility from the identified combination of Invention I by itself or in other combinations. Thus, the Restriction Requirement concluded that restriction for examination purposes is proper.

The Examiner's attention is initially directed to MPEP 806.05(c) which explicitly states that "[t]o support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary" (emphasis added). In this regard, the Restriction Requirement does not establish two-way distinctness as required under MPEP 806.05(c) for a proper Restriction Requirement based on an identification of combination and subcombination inventions.

The Examiner's attention is also respectfully directed to MPEP 803 which explicitly sets forth that "if the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions". In this regard, the Restriction Requirement does not establish the existence of a "serious burden" if examination of both identified Inventions were required. Accordingly, it would appear that examination of both identified Inventions would not impose any burden on the Examiner.

Accordingly, for each of the above reasons, it is respectfully submitted that the Restriction Requirement is inappropriate. For these reasons, and consistent with office policy as set forth in MPEP 803 and 806.05(c), Applicants respectfully request reconsideration and withdrawal of the Restriction Requirement. Nevertheless, in order to be fully responsive, Applicants have elected with traverse the embodiments of the invention identified as Invention I, to which the claims of Group I (i.e., claims 1-8 and 16-23) are directed (as identified by the Examiner), for prosecution on the merits in the event that the Examiner chooses not to reconsider and withdraw the Restriction Requirement.

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Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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